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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,385	04/30/2004	Marcus Steen	00173.0054.PCUS00	1682
28694	7590	09/19/2006	EXAMINER	
NOVAK DRUCE & QUIGG, LLP 1300 EYE STREET NW 400 EAST TOWER WASHINGTON, DC 20005			PANG, ROGER L	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/709,385	<b>Applicant(s)</b> STEEN ET AL.	
	<b>Examiner</b> Roger L. Pang	<b>Art Unit</b> 3681	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10 and 12 is/are rejected.
- 7) ☒ Claim(s) 6-8 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-30 and 9-1-04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The following action is in response to the amendment filed for application 10/709,385 on August 4, 2006.

#### ***Election/Restrictions***

Claims 13-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 4, 2006.

Applicant argues that there are no specific grounds for said restriction. It can be shown, however, that different classifications for both groups have been disclosed as a reason for the restriction, along with the different control means used. Applicant's arguments have been considered, but are not persuasive and the restriction is still considered proper.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Sweden on October 31, 2002. It is noted, however, that applicant has not filed a certified copy of the PCT (PCT/SE02/01992) application as required by 35 U.S.C. 119(b).

#### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless

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the references have been cited by the examiner on form PTO-892, they have not been considered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 2, in line 2, the limitation of “the highest permitted gear” lacks antecedent basis. With regard to claim 12, on line 1, the limitation of “the elements” lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rauch '510. With regard to claim 1, Rauch teaches a vehicle comprising a drivetrain, having an internal combustion engine 36 and a gearbox 14 coupled to the internal combustion engine, and a control unit 16 for automatic gear selection as a function of the current rotational speed of an input shaft to the gearbox ( $V_{sp} = IS \times GR$ ), in which the control unit has a first operating mode (cold start) with a first working speed range defined by a first lower limit A3 for downshifting to a gear with a higher transmission ratio, wherein the control unit has a second operating mode

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with a second working speed range defined by a second lower limit A1 for downshifting to a gear with a higher transmission ratio, in which the second limit A1 is lower than the idling speed (1200rpm for cold start) of the internal combustion engine and is equal to a lower rotational speed than the first lower limit ( $A1 < A3$ ). With regard to claim 2, Rauch teaches the vehicle, wherein the control unit comprises a memory unit in which a representation of the highest permitted gear in the second working speed range is stored (the highest gear in the transmission). With regard to claim 3, Rauch teaches the vehicle, wherein the control unit is configured to select the highest permitted gear or a gear lower than the highest permitted gear when the control unit has assumed the second operating mode (i.e. 4-3 downshift). With regard to claim 4, Rauch teaches the vehicle, wherein the control unit is coupled to elements 40 for indicating the selection of first or second operating mode. With regard to claim 5, Rauch teaches the vehicle, wherein the vehicle contains an engine management unit 20, which comprises an idling speed regulator (throttle), the idling speed regulator being designed to control the torque delivered from the internal combustion engine when the vehicle is operated at idling speed in the second operating mode (engine is held at idling during closed throttle = engine control). With regard to claim 9, Rauch teaches the vehicle, wherein the vehicle contains elements (parts of 16) for establishing that the internal combustion engine is delivering sufficient torque for operation of the vehicle at an operating speed equal to a rotational speed of a gearbox input shaft below the first limit. With regard to claim 10, Rauch teaches the vehicle, wherein the drivetrain contains a clutch unit 48 arranged between the internal combustion engine and the gearbox, the drivetrain being divided into a first part up to the clutch unit and comprising the internal combustion engine and a second part from the clutch unit onwards and comprising the gearbox, characterized in

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That the second limit A1 for downshifting is equal to a speed lower than the idling speed (1200rpm during cold start) of the internal combustion engine, that the vehicle contains a sensor TSS for measuring the current rotational speed, and that the sensor is designed to measure the rotational speed in the second part of the drivetrain, the clutch unit being designed to absorb a speed differential between the rotational speed of the first and second parts of the drivetrain where insufficient torque has been delivered by the internal combustion engine, following which a rotational speed equal to the second downshifting limit is reached and downshifting is permitted. With regard to claim 12, Rauch teaches the vehicle, wherein the elements for indicating selection of the first or second operating mode comprise a throttle lever forming part of the vehicle, the control unit being designed to assume its second operating mode should the throttle lever be released into an idling position whilst in motion (and while it is in the cold start condition).

### ***Allowable Subject Matter***

Claims 6-8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shin, Gutknecht-Stohr, Kondo, Tinschert, Mori, Kusafuka, Suzuki, Genise, and Saito have been cited to show similar transmission controls.

FACSIMILE TRANSMISSION

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Submission of your response by facsimile transmission is encouraged. The central facsimile number is (571) 273-8300. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on \_\_\_\_\_ (Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_  
\_\_\_\_\_

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roger L. Pang whose telephone number is 571-272-7096. The examiner can normally be reached on 5:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system; see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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A handwritten signature in black ink, appearing to read 'R. Pang', with a stylized flourish extending to the right.

Roger L. Pang  
Primary Examiner  
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September 14, 2006